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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/346,063	07/01/1999	KENT J. SIEFFERT	1551.011US1	1973
70859 7590 11/21/2007 SCHWEGMAN, LUNDBERG & WOESSNER/CPA P.O. BOX 2938 MINNEAPOLIS, MN 55402			EXAMINER NGUYEN, NGA B	
			ART UNIT 3692	PAPER NUMBER
			MAIL DATE 11/21/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/346,063

Applicant(s)

SIEFFERT ET AL.

Examiner

Nga B. Nguyen

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2005 and 21 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5 and 10-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action is the answer to the Amendment filed on July 25, 2005 and the Election filed on September 21, 2007, which paper has been placed of record in the file.
2. Claims 5 and 10-14 are pending in this application.

### ***Response to Arguments/Amendment***

3. Applicant's election without traverse of Group III (Claims 5 and 10-14) in the reply filed on September 21, 2007 is acknowledged.
4. Applicant's arguments with respect to claims 5 and 10-14 have been considered but are moot in view of new grounds of rejection.
5. Applicant's amendment (the Amendment filed on July 25, 2005) necessitated the new grounds of rejection presented in this Office action.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 5 and 10-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Kossovsky et al (hereinafter Kossovsky), U.S. Patent Application Publication No. 2002/0004775.

Regarding to claim 5, Kossovsky discloses a method for facilitating transfer of an interest in an intellectual property asset via global computer network, the method comprising:

formulating a proposed transfer of an interest in an intellectual property asset based on input submitted by a network user (paragraphs 0043-0044, seller submits data describing the IP listed on the exchange);

presenting one or more terms for the proposed transfer (paragraphs 0043-0044, seller submits data describing the IP listed on the exchange and figures 5A-5C);

permitting the network user to select one or more of the terms (paragraphs 0043-0044, seller submits data describing the IP listed on the exchange and figures 5A-5C);

limiting bidders via an access profile (paragraph 0064 and 0153);

defining the proposed transfer based at least part on the terms selected by the user (paragraphs 0043-0044, seller submits data describing the IP listed on the exchange and figures 5A-5C); and

posting the proposed transfer on a network resource residing on the global computer network (paragraphs 0043-0044, seller submits data describing the IP listed on the exchange).

Regarding to claim 10, Kossovsky discloses a method for facilitating transfer of interests in intellectual property assets via a global computer network, the method comprising:

auctioning an interest in an intellectual property asset via a network resource residing on the global computer network, wherein auctioning an interest includes listing, as part of an auction process, an asset identifier corresponding to the asset and terms of transfer of the interest in the intellectual property asset (paragraphs 0043-0044, seller submits data describing the IP listed on the exchange);

limiting access to the asset identifier and the terms of transfer as a function of an access profile associated with each network user (paragraphs 0064 and 0153);

gathering bids from network users (paragraph 0172, the participants submit bids to the exchange); and

adjusting the terms of transfer in the event no sufficient bids are gathered within a predetermined period of time (paragraph 0173, e.g., the exchange auction master can start at a low bid, increase bid until the number of buyers willing to buy his merchandise matches his inventory)).

Regarding to claim 11, Kossovsky discloses wherein limiting bidders via an access profile includes accessing a database of access profiles, wherein each network user has an associated access profile (paragraph 0153).

Regarding to claim 12, Kossovsky discloses a method for auctioning an interest in an intellectual property asset via a global computer network, the method comprising:

offering the interest in the intellectual property asset via a network resource residing on the global computer network, wherein the interest in the intellectual property asset is defined by a proposed transfer agreement and a profile of users granted access to the proposed transfer agreement (paragraphs 0043-0044, seller submits data describing the IP listed on the exchange; paragraphs 0064 and 0153);

collecting bids from network users meeting the profile of users granted access to the proposed transfer agreement (paragraph 0172, the participants submit bids to the exchange); and

accepting a bid (paragraphs 0050-0051, seller accept bid).

Regarding to claim 13, Kossovsky discloses wherein the proposed transfer agreement is a proposed licensing agreement (paragraph 0009).

Regarding to claim 14, Kossovsky discloses wherein the in intellectual property asset is a patent (paragraph 0009).

***Conclusion***

8. Claims **5** and **10-14** are rejected.
9. The prior arts made of record and not relied upon is considered pertinent to applicant's disclosure:

Kossovsky et al. (US Publication 2002/0002524) disclose an online patent and license exchange which enables potential licensors and licensees of patents and other intellectual property rights to efficiently and reliably transact IP license or assignment agreements.

Kossovsky et al. (US Publication 2002/0002523) disclose an online patent and license exchange.

Detering (US 7,287,007) discloses a method of making intellectual property goods available by determining and charging prices that reflect the value that consumers assign to an increased variety and quality of those goods available for their use.

[http://www.eurekaalert.org/pub\\_releases/1999-01/FI-PART-220199.php](http://www.eurekaalert.org/pub_releases/1999-01/FI-PART-220199.php), "PLX Announces Plans To Revolutionize \$3.5 Billion Patent Industry Through Global, Internet-Based Patent Auction Market."

The Patent & License Exchange, Inc., House Rules, Copyright 1999.

"Electronic Design; An Internet "Exchange Aims To Revolutionize Trading In Intellectual Property Patents", Penton Media, Inc, March 22, 1999.

The Recorder, "Law Inc., Business and Technology; Are Patents Next for The Online Auction Block?", May 20, 1999.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communication intended for entry),

or

(571) 273-0325 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Knox building, 501 Dulany Street, Alexandria, VA, First Floor (Receptionist).



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A handwritten signature in cursive script, appearing to read "Nga Nguyen".

NGA NGUYEN  
PRIMARY EXAMINER

November 7, 2007